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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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11/28/2001

Thomas A. Koes

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23389

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03/21/2008

SCULLY SCOTT MURPHY & PRESSER, PC

400 GARDEN CITY PLAZA

SUITE 300

GARDEN CITY, NY 11530

EXAMINER

LEE, SIN J

ART UNIT

PAPER NUMBER

1795

MAIL DATE

DELIVERY MODE

03/21/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/995,880	Applicant(s) KOES, THOMAS A.	
	Examiner Sin J. Lee	Art Unit 1795	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 January 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 6, 8-12, 17 and 18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 6, 8-12, 17, 18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 12, 17 and 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 12, applicants recite “[a] method . . . consisting essentially of the step of. . .”. In claim 18, applicants also recite “[a] method . . . consisting essentially of the steps”. Are applicants trying to exclude steps other than what is recited in those claims? Or, did applicants mean to use such transitional phrase for the photoresist composition recited in those claims?

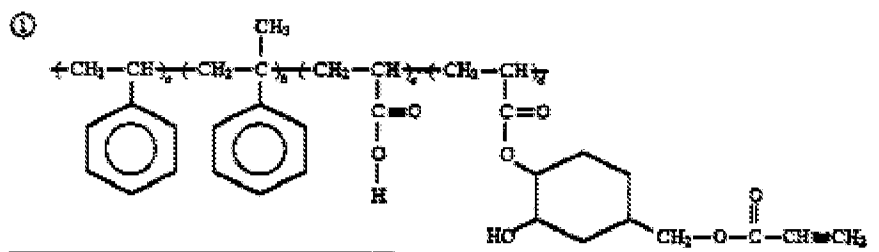
Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
4. Claims 1, 6-12, 17 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Urano et al (5,800,952) (with Yamada et al (6,033,829) which is being cited here to show that 2-mercaptobenzothiazole is a compound that is added to a photopolymerizable composition to further increase performance of a photopolymerization initiator).

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In Comparative Examples 6 and 9 (see Table 2, and see also the last three lines of col.15-16, first fifteen lines of col.17-18, and col.4, lines 15-17, col.16, lines 48-58), Urano teaches a photopolymerizable composition containing a photopolymerization initiator system II including R-1 (2,2'-bis(o-chlorophenyl)-4,4',5,5'-tetraphenylbiimidazole), Michler's ketone (N,N'-tetramethyl-4,4'-diaminobenzophenone) and 2-mercaptobenzothiazole, an ethylenic compound, 24 parts of an organic polymer material (1) (with acid value of 80) which is shown below, and 3 parts of an additive which is one of oxalic acid and phthalic acid:



Therefore, Urano teaches present 5 parts of the organic acid per 40 parts of polymeric binder. Urano coats his composition onto a substrate, followed by exposure and development. Thus, Urano teaches present inventions of claims 1, 6-12, 17 and 18; even though present claim 1 recites "[a] photoresist composition consisting essentially of . . .", it is the Examiner's position that 2-mercaptobenzothiazole of Urano's composition would not materially affect the basic and novel characteristic(s) of the claimed invention because 2-mercaptobenzothiazole is merely a compound that is added to a photopolymerizable composition to further increase performance of a photopolymerization initiator as evidenced by Yamada, col.10, lines 7-14. Thus, it is the

Examiner's position that Urano's composition still teaches present composition. See MPEP 2111.03.

Response to Arguments

5. Applicants argue that the presence of a thiazole-containing compound is excluded from the contemplation of *all* the claims of the present application. First of all, it is *only* present claim 1, which claims the composition "consisting essentially of . . .". The other independent claims 12 and 18 still use the open-ended "comprising" language *with respect to the composition*. Secondly, as already explained above, it is the Examiner's position that 2-mercaptobenzothiazole of Urano's composition would not materially affect the basic and novel characteristic(s) of the claimed invention because 2-mercaptobenzothiazole is merely a compound that is added to a photopolymerizable composition to further increase performance of a photopolymerization initiator as evidenced by Yamada. The transitional phrase "consisting essentially of" limits the scope of a claim to the specified materials or steps "and those that do not materially affect the basic and novel characteristic(s)" of the claimed invention. In re Herz, 537 F.2d 549, 551-52, 190 USPQ 461, 463 (CCPA 1976). For the purposes of searching for and applying prior art under 35 U.S.C. 102 and 103, absent a clear indication in the specification or claims of what the basic and novel characteristics actually are, "consisting essentially of" will be construed as equivalent to "comprising." See, e.g., PPG, 156 F.3d at 1355, 48 USPQ2d at 1355. If an applicant contends that additional steps or materials in the prior art are excluded by the recitation of "consisting essentially

of,” applicant has the burden of showing that the introduction of additional steps or components would materially change the characteristics of applicant’s invention. In re De Lajarte, 337 F.2d 870, 143 USPQ 256 (CCPA 1964). See also Ex parte Hoffman, 12 USPQ2d 1061, 1063-64 (Bd. Pat. App. & Inter. 1989). See MPEP 2111.03.

Also, applicants argue that Urano teaches away from utilizing an oxalic acid and phthalic acid in photopolymerizable composition. However, applicants’ such argument is unpersuasive because present rejection over Urano is a 102(b) rejection, not a 103(a) rejection. Since Urano’s Comparative Examples 6 and 9 teach every component of present claims 1, 12 and 18, Urano does teach present inventions of those claims.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sin J. Lee whose telephone number is 571-272-1333. The examiner can normally be reached on Monday-Friday from 9:00 am EST to 5:30 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly, can be reached on 571-272-1526. The fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Sin J. Lee/

Primary Examiner, Art Unit 1795

March 14, 2008